

## REMARKS

### Status of the Application

Applicants respectfully request reconsideration of the position set forth in the outstanding Final Office Action mailed July 23, 2004. Claims 1-6 are pending in the application. Per the Final Office Action mailed July 23, 2004, Claims 1, 3-4 and 6 stand as rejected under 35 U.S.C. §102, and Claims 2 and 5 are rejected under 35 U.S.C. §103.

Applicants respectfully request the Examiner to withdraw the finality of the Office Action mailed July 23, 2004, as the Examiner has provided a new basis for rejection based on JP-4-130190 (Kaoru).

Under Section 706.07(a) of the MPEP, “[u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).”

With respect to the first element described above, Applicants' previous amendment was directed to spraying the surface treatment agent directly to the surface of the drum dryer and the lack of staining of the paper strip. Thus, Applicants' amendment of the claims did not necessitate the new ground of rejection asserted by the Examiner regarding the spray rate of a release agent onto a surface of a Yankee drum dryer. With respect to the second element, the Kaoru reference was not submitted to the USPTO in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Rather, the Kaoru reference was submitted to the USPTO in an Information Disclosure statement received on March 23, 2001, however, was not considered until July 20, 2004. Therefore, Applicants respectfully request that the finality of this rejection be withdrawn.

Claim 1 has been amended to recite the term "surface treatment agent containing oil" rather than "release agent". The amendment was made solely for reasons of clarity and not for reasons of patentability or in response to any rejection.

**Rejections under 35 U.S.C. §102**

Claims 1, 3-4, and 6 stand as rejected under 35 U.S.C. §102(b) as being anticipated by JP-4-130190 (Kaoru).

The Examiner alleges the following: "Kaoru discloses a method of cleaning a surface of a papermaking rotating dryer drum wherein a release agent, an emulsified oil solution, is applied to the surface of the drum by direct spraying onto the surface. The oil penetrates the asperities on the surface of the drum and forms a film on the surface of the drum. The oil is then absorbed by the cellulose fibers of a paper strip, which rides on the drum. Example 3 discloses continuous spraying at a rate of 2.0 l/min. onto a surface of a Yankee drum dryer, without staining the paper strip by the release agent (Kaoru, translation, pages 2-5)."

The Examiner further alleges that the emulsified solution mixture contains 20 parts of oils and 1000 parts of water (working example, pg. 3). Thus the ratio of water to oils is 50 to 1.

Applicants believe the Examiner's assertion regarding the spray rate to be conclusory because no evidence is provided regarding how Kaoru's spray rate of 2.0 L/min. is comparable to that of the present invention. Accordingly, Applicants do not believe the Examiner has shown Kaoru to be anticipatory of the present invention.

Kaoru does not disclose or suggest the amount of oil supplied to the surface of the drum dryer as described in the present invention. Kaoru discloses the width of the drum dryer to be 3m, however parameters such as the rotating speed or surface speed of the drum dryer or the paper speed are not disclosed. Thus, the spray rate per minute and per area of Kaoru is not described, and therefore, Kaoru does not specify the spray rate in accordance with that provided by the present invention (mg/m<sup>2</sup>/minute). As a result, the spray rate of Kaoru is not within the scope of the spray rate utilized by the present invention and Kaoru cannot anticipate Claims 1, 3 and 4 of the present invention.

Furthermore, since Applicants believe Claims 1 and 3-4 to be patentable and Claim 6 depends from Claim 1, Applicants believe Claim 6 to be patentable.

**Rejections under 35 U.S.C. §103**

Claim 2 stands as rejected under 35 U.S.C. §103(a) as obvious over JP-4-130190 (Kaoru).

Applicants respond that Claim 1 is believed to be patentable and non-obvious with respect to Kaoru as is described above, and since Claim 2 depends from Claim 1, Claim 2 is also believed to be patentable and non-obvious with respect to Kaoru.

Claim 5 stands as rejected under 35 U.S.C. §103(a) as obvious over JP-4-130190 (Kaoru) in view of U.S. Patent 3,014,832 (Donnelly).

Applicants respectfully assert that the Examiner has failed to establish a prima facie case of obviousness, and therefore the combination of the Kaoru and Donnelly do not render Applicants' claimed invention obvious.

Section 2142 of the MPEP (*Eighth Edition*, Incorporating Revision No. 2) indicates that a prima facie case of obviousness is only established when there is 1) some suggestion or motivation to modify or combine the cited prior art references, 2) a reasonable expectation of successfully producing the claimed invention via such a combination, and 3) all of the claim limitations are either taught, or suggested by the cited prior art. Section 2143 further explains that “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in applicant's disclosure.”

With respect to the combining of references, Section 2143.01 of the MPEP indicates that, in accordance with the Federal Circuit's decision in *In re Mills*, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is no motivation or suggestion in Kaoru or Donnelly to combine the two references in order to arrive at Applicants' invention.

More specifically, there is neither a motivation or suggestion to combine Donnelly and Kaoru nor a reasonable expectation of successfully producing the claimed invention via the combination of references since, based on the teachings of Donnelly, the release agent is used only in conjunction with the web, because the web adheres to the drying cylinder with some degree of adhesion, and hence, the release agent is applied to the web to control or reduce its level of adhesion. In

column 6, lines 34-49, Donnelly describes the application of the release agent, wherein it states “[t]he pressure applied at the nip by the press roll 19 spreads and distributes the release agent evenly in the web. It is an important part of the [Donnelly] invention that the release agent be uniformly distributed in the web so that it is present uniformly on the surface of the web as well.” (Emphasis added). Moreover, Donnelly discloses the purpose of applying the release agent to the web, in column 7, lines 7-14, where the release agent lubricates the fiber structure of the formed tissue web, so that the fibers slide over one another more easily, or are partially plasticized so that the web can be stretched to a greater extent without rupturing, wherein the release agent changes the properties of the web, and the fibers of the web are partially plasticized. Therefore, Donnelly explicitly indicates that the application of the release agent directly to the surface of the web and its migration into the web are key features to the invention, as claimed in both claims 1 and 2. Donnelly, at no point, indicates that the release agent should be directly applied to the drum dryer surface. The application of any release agent to the dryer surface in Donnelly, as was previously noted, is simply incidental, and application directly to the dryer surface or into the nip is neither taught nor suggested by Donnelly. Moreover, in claims 1 and 2, Donnelly explicitly states that a specific step in its process is “applying to the formed tissue web before drying a fluid containing a release agent.” Therefore, according to Donnelly’s claims, the release agent must be applied to the tissue web.

As a result, one skilled in the art would not find a motivation or suggestion to combine Donnelly and Kaoru or a reasonable expectation of successfully producing the claimed invention via the combination of references that would result in the present invention because Donnelly, if taken as asserted by the Examiner, teaches away from Kaoru. For example, the Examiner asserts that Donnelly’s Example 1 uses an oil-in-water emulsion having 6% oil and 94% water (and a water to oil ratio of 15.7), however, this disclosure would be relevant only when the release agent is desired to be applied to the web, as shown in Column 8, lines 50-62. Yet the Examiner has asserted that Kaoru discloses a method of cleaning a surface of a paper making rotating dryer drum wherein a release agent, an emulsified oil solution, is applied to the surface of the drum by direct spraying onto the surface. Thus, the oil-in-water emulsion percentages supplied by the Examiner would not provide any

motivation to combine the references or a reasonable expectation of successfully combining the references since such values are not applicable to Kaoru.

Furthermore, the combination of references does not teach or suggest all of the claim limitations. Neither Donnelly nor Kaoru disclose or suggest the amount of oil supplied to the surface of the drum dryer as described in the present invention. Kaoru discloses the width of the drum dryer to be 3m, however parameters such as the rotating speed or surface speed of the drum dryer or the paper speed are not disclosed. Thus, the spray rate per minute and per area of Kaoru are not described. Therefore, since Kaoru cannot specify the spray rate in accordance with that provided by the present invention ( $\text{mg/m}^2/\text{minute}$ ) and Donnelly does not provide spray rates for application of the release agent directly to the surface of the drum dryer the combination of references does not teach or suggest all of the claim limitations.

Therefore, Applicants believe that the cited references either alone or in combination do not render the present invention obvious under 35 U.S.C. §103(a). It is respectfully requested that these rejections be withdrawn.

## SUMMARY

In view of the foregoing amendments and remarks, Applicants believe the stated grounds of rejection have been properly traversed, accommodated, or rendered moot and that a complete response has been made to the Final Office Action mailed July 23, 2004. Applicants believe that the application stands in condition for allowance with withdrawal of all grounds of rejection. A Notice of Allowance is respectfully solicited. If the Examiner has questions regarding the application or the contents of this response, the Examiner is invited to contact the undersigned at the number provided below.

The Applicants believe that a fee is due in accordance with this response for a two-month extension of the period for reply, however should any other fee be due that is unaccounted for, please charge such fee to Deposit Account No. 501447 (Potter Anderson and Corroon LLP). Furthermore, if any extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefore are hereby authorized to be charged to our Deposit Account No. 501447.

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Respectfully submitted,

By 

Thomas R. Mancini, Esquire  
Reg. No. 50,157  
Potter Anderson & Corroon LLP  
PO Box 951  
Wilmington, DE 19802  
Attorney for Applicants  
Telephone: (302) 984-6127  
Facsimile: (302) 658-1192

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